



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/606,835

06/27/2003

Kazuhiro Nakamura

KAS-184

4821

7590 12/17/2008
MATTINGLY, STANGER & MALUR, P.C.
Suite 370
1800 Diagonal Road
Alexandria, VA 22314

EXAMINER

GORDON, BRIAN R

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

12/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/606,835	Applicant(s) NAKAMURA ET AL.	
	Examiner Brian R. Gordon	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3 and 6-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3 and 6-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed December 13, 2008 have been fully considered but they are not persuasive.

During the interview held on May 30, 2008 the examiner stated applicant should review the specification to ensure the proposed amendments are fully supported by the original specification. The amendments contain new matter as explained herein.

There is no support for the computer management system 11, functioning as claimed.

Applicant has amended the claims in a manner which does not further clarify structure of the device.

See further explanations herein.

Specification

2. The amendment filed December 13, 2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: see Response to Arguments and 112 Rejection.

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction

of the following is required: There is appears to be no antecedent basis in the specification for the limitations of claims 6-7.

There is no antecedent basis in the specification for “a new reagent detection unit” as stated in claim 3.

4. There is no antecedent basis in the specification for the mechanism as claimed in claim 7.

To ensure the claims are fully supported by the specification and the claims are not directed to new matter, the examiner hereby requests applicant to fully disclose where all the claim limitations are supported in the original specification.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 6 and 11-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant asserts claim 6 is supported at page 15. There is no mention of the buffer on page 15. However, the examiner assumes the term buffer is intended to refer to the standby unit 9. There is no mention that a module computer of an analyzer places the standby unit in a stand by state as claimed. The specification discloses the standby

unit has a computer 17. Furthermore as presently drafted it is unclear what is placed in a standby state. Is it the buffer of a sample?

There is no mention in the specification that the management computer registers reagents as claimed. The term "register" or any derivative thereof only appears in paragraphs 0044, 0049, and 0053 and original claim 4 (of publication 2004/0091396 of instant application). The examiner fails to locate within the passages where it is disclosed that the management computer 11 registers reagents as claimed.

Original claim 4 was directed to a register unit. However the register unit was not disclosed as being equivalent to the management computer.

Claim 12 has been amended to incorporate a negative limitation of at least one of the analyzing apparatuses contains a reagent that is not registered in the analyzing system. The original specification does not disclose or provide support for the negative limitation as claimed.

Applicant asserts the portion of claim 11 directed to the management computer is supported at page 8. The examiner respectfully disagrees. There is no mention of the management computer on page 8 of the specification. The management computer is only mentioned in terms of registering the module 5 which is not the same as registering particular reagents in the analyzing system.

Applicant has claimed the management computer is programmed to perform a number of functions. However such functions are not disclosed as being controlled by management computer in the specification.

The new matter should be canceled from the claims and specification.

7. Claims 3 and 6-12 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a system including analyzing modules, module computers, shortage detection unit, and a management computer, does not reasonably provide enablement for such a system functioning without the plurality of analyzing modules. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Applicant has amended claim 11 to further incorporate a plurality of module computers, but applicant has not positively claimed the respective plurality of analyzing modules (apparatuses). While the analyzing apparatuses are mentioned in the preamble of the claim, it should be noted the invention is defined by the elements following the transitional phrase, comprising.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 3 and 6-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 3 it is unclear what is meant by "newly set" and "new reagent". What is the relationship of the "new reagent" to the respective reagent in each analyzing apparatus of claim 11.

Claim 11 as understood by the examiner is intended to be directed to a plurality of analyzing apparatuses and plurality of corresponding module computers. Each of the respective computers being programmed to function the same, including being stopped.

However claims 6, 8, and 9-10 reference "the analyzing apparatus" and/or "the corresponding module computer". It is unclear which of the plurality of analyzing apparatuses and computer modules applicant is referencing. There is no distinction made within the claims.

As to claim 6, there is no antecedent basis for "the reagent to be replaced".

As to claims 7-8, there is no antecedent basis for "the reagent replaced".

As to claim 7, there is no antecedent basis for the "mechanism" as claimed.

Applicant asserts the mechanism is the detector as described at page 16.

However, the specification does not refer to the detector 80 as "a mechanism" functioning as claimed. The passage at page 16 described. There is no mention in the specification of an "automatic measurement" occurring by the detector/mechanism. The passage discloses module computer functions to detect in response to the detector 80 which responds to a signal from surface detection sensor. It appears as if there is a combination of elements that function to provide for the detection. Where is it disclosed that the detector/mechanism alone performs any automatic measurement as claimed? The terms "automatic" and "measurement" are not mentioned in the passage.

Claim 9 makes reference to "an identifier". The identifier is not positively claimed as an element of the invention. Therefore, the identifier is not further limiting of the device.

As to claim 12, it is unclear which of the module computers is being "referenced" by the phrase "said module computer".

.Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, 1st Fri. Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian R Gordon/
Primary Examiner
Art Unit 1797